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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/944,383

NOV 16 2007

Filing Date: September 04, 2001

Appellant(s): CAN ET AL.

GROUP 3600

Michael Bednarek
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/13/07 appealing from the Office action

mailed 7/6/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,313,745	Suzuki	11-2001
6,127,928	Issacman et al.	10-2000
5,572,653	DeTemple et al.	11-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35 and 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 35 and 37 recite a step of subtracting, which is not disclosed in the specification. On page 11 of applicant's arguments, applicant asserts that such disclosure (paragraph 0028) encompasses the subtracting recited in amended claims. The examiner does not concur. The specification does not disclose subtraction.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-37, 48 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of DeTemple et al.

Suzuki shows all of the limitations of the claims except for specifying using the RF tags to determine their locations on a sales floor and correlating garments taken into the fitting room with their store location.

Suzuki shows, figure 9, a system and method for tracking and recognizing merchandise items (garments) taken into a fitting room by a customer for providing more efficient customer assistance. Each merchandise item is attached to a wireless tag (RFID) including a product identifier. A fitting room is equipped with an antenna/receiver unit, which interrogates the wireless tag of an item taken into the fitting room to be tried-on. A store server (capable of displaying as much as applicant's disclosure) retrieves information about the item based on the product identifier, and presents such information to a store clerk through an in-store terminal. In addition, the server develops recommendation of other products that the customer might be interested based upon the items taken into the fitting room. The server includes an analysis (determining) and recommendation (reporting, displaying) engine that analyses the style, color, and brand of each of the items in the fitting room, and develops

recommendations accordingly. Figure 9 show a trial history including tried and purchased or not purchased data (correlation). Suzuki shows a relationship in as much as applicant does.

Issacman et al. teaches a method of using RFID tags to automatically and rapidly locating and tracking objects throughout a facility (using the RF tags to determine their locations) in order to be able to use the object's location information.

Based on the teaching of Issacman et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Suzuki database to include the Issacman tracking system locations in order to be able to use the object's location information.

DeTemple et al. teaches a remote electronic information display system for a retail facility. Data is collected on the customer location, product location, price and customer demographics. From column 9, line 44-46, data can be manipulated and sorted as a function of price, product location, advertising, customer demographics, store and product location, environment, etc. (correlating products with their store location) in order to understand customer behavior and increase sales.

Based on the teaching of DeTemple et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Suzuki database to include the DeTemple data manipulation, including correlating products with their store location, in order to understand customer behavior and increase sales.

(10) Response to Argument

Compliant appeal brief issue

Appellant has received two non-compliant appeal briefs in the past. The current brief is still non-compliant per 37 CFR 41.37 (c)(1)(ix), for reference to evidence not entered. On page 10, appellant makes reference to a new dictionary definition of the verb "correlate". In order to better serve the customer, the office would like to keep prosecution progressing. After two non-compliant briefs, the office will send an examiner's answer. The board can make the decision if the error is too great to continue. A call was made to appellant on 9/25/07 to discuss the matter and they preferred to get the Examiner's Answer and risk the delay if the board remands the case at a later date.

35 USC 112, 1st

Appellant asserts that the examiner has not made a *prima facie* case because of the simple statement that the specification does not disclose subtraction. The examiner does not concur because subtraction is a subgenus of the genus correlation. A simple statement is adequate to show that the subgenus of subtraction was not within the scope of the original discloser and that one can correlate without necessarily subtracting. See MPEP 2163, B, *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) (a subgenus is not necessarily described by a genus encompassing it and a species upon which it reads). Appellant cites *In re Alton*, but omits a middle sentence that If the applicant claims embodiments of the invention that are outside the

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scope of the specification, then the examiner or Board need only establish this fact to make out a *prima facie* case.

Bottom of page 6, appellant asserts that when comprehended within the context of the remaining teachings of Applicants' disclosure and the knowledge of one skilled in the art, fully supports the steps of "subtracting". The examiner believes that appellant is confusing the criteria for enablement with written description. Written description requires that a person of ordinary skill would have understood that the description requires the missing limitation. *Hyatt v. Boone*, 47 USPQ2d 1131 (Fed. Cir. 1998). In this case, correlation could be achieved by graphical regression or possible use of ratios and subtraction is not required.

As for the question if appellant was in possession of the invention as now claimed. The examiner does not believe so. Appellant could not overcome the prior art without becoming more specific than the disclosure of correlating data. Appellant's cited support in the "summary of the invention" section of this appeal brief supports the examiner's conclusion.

35 USC 103 arguments

The examiner fully claimed mapped claim 35 and will rely on that and the original rejection to show the claimed subject matter. As for motivation, the examiner will also rely on the original rejection and the guidance the recently decided KRS case.

Claim Map for Claim 35

associating a radio frequency identification (RFID) tag with each garment of a plurality of garments in the retail store;

associating each RFID tag with style information of its associated garment;

scanning the RFID tagged garments to determine their merchandising locations on a sales floor of the retail store;

scanning the RFID tagged garments that are taken to a fitting room of the retail store by a plurality of customers;

scanning the RFID tagged garments that are purchased after being taken to the fitting room;

subtracting the RFID tagged garments that are purchased after being taken to the fitting room from the RFID tagged garments that are taken to the fitting room to yield tried-on-but-not-purchased RFID tagged garments; and

displaying, for a tried-on-but-not-purchased RFID tagged garment, the frequency with which the tried-on-but-not purchased RFID tagged garment is tried on, style information of the tried-on-but-not-purchased RFID tagged garment, and the merchandising location of the tried-on-but-not-purchased RFID tagged garment.

Claim Map for 09/944,383

Suzuki. Wireless tags, 10. See column 4, lines 25-31.

Suzuki. Column 2, lines 15-17.

Issacman. Title, invention uses RFID tags to locate items throughout a facility.

Issacman. Title, invention uses RFID tags to locate items throughout a facility.

Issacman. Title, invention uses RFID tags to locate items throughout a facility.

Tried on items = tried on purchased items + tried on not purchased items. Suzuki, figure 9, already shows the items that are tried on, but not purchased. DeTemple teaches data manipulation in the same field. (Column 9, lines 44-46) The mere function of subtraction to derive a value of a simple equation is obvious.

Suzuki. Column 9, lines 9-16.
(Take note of appellant's summary of invention. "Displaying" is enabled by "data showing", not a graph or chart.)
Suzuki tracks and stores the same data, therefore, its data shows or displays the same as appellant.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Cuff

/Michael Cuff/

Primary Examiner, Art Unit 3627

Conferees:

Vincent Millin



Ryan Zeender

